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VENABLE LLP P.O. BOX 34385 WASHINGTON, DC 20043-9998				
EXAMINER				
CALANDRA, ANTHONY J				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/564,775

## Applicant(s)

SIPILA ET AL.

## Examiner

ANTHONY J. CALANDRA

## Art Unit

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 2 May 2007 and 17 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 22-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-43 is/are rejected.
- 7) ☒ Claim(s) 27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/08)  
Paper No(s)/Mail Date 4/24/2006 1/17/2006
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Detailed Office Action***

1. The communications dated 1/17/2006 and 5/2/2007 have been entered and fully considered.
2. Claims 1-21 have been cancelled by the applicant. Claims 22-43 are currently pending.

***Claim Objections***

3. Claim 27 is objected to because of the following informalities:

Claim 27 appears to be missing a '-' on line 5 "cages being 1500 m/s, typically 50-200 m/s". Examiner has interpreted this as 1-500 m/s.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 26-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 26 the term "powerful" in claim 26 is a relative term which renders the claim indefinite. The term "powerful" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. A person of ordinary skill would not know what force is necessary to be exerted of the fibers as for it to be a 'powerful' force

In claim 27, a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 27 recites the broad recitation 1-500 m/s, and the claim also recites 50-200 m/s which is the narrower statement of the range/limitation.

Claim 28 is dependent on claim 27 and is similarly rejected.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
8. Claims 22-25, 29, 30, 31, 32, 33, 34, 35, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,223,090 KLUNGNESS et al., in view of U.S. Patent 6,416,727 VIRTANEN, hereinafter VIRTANEN and Handbook for Pulp and Paper Technologists by SMOOK, hereinafter SMOOK.

As for claim 22, KLUNGNESS discloses a method for manufacturing paper loaded with calcium carbonate [abstract]. KLUNGNESS discloses a precipitation reactor, the refiner (*providing a precipitation reactor* [column 7 lines 5-12]). KLUNGNESS discloses that the fibers, which have a capacity for bonding, are sent to the refiner after being mixed with calcium hydroxide, a reactive mineral (*providing a fiber material comprising fibers to be used as a raw material for the paper pulp, the fibers in the fiber material having a certain capacity for bonding and providing a reactive mineral material* [column 1 lines 25-29, column 6 lines 8-17, column 7 lines 7-12]). KLUNGNESS then discloses carbon dioxide a gas capable of precipitating out the reactive mineral (*providing a gas containing a precipitant capable of precipitating the reactive mineral material* [column 7 lines 16-20]). The refiner plates of KLUNGNESS et al. act as a precipitation zone within the reactor (*providing an activation zone in front of the precipitation reactor or inside the precipitation reactor* [column 7 lines 5-12]). The calcium hydroxide and fibers are combined to form a suspension (*combining the reactive mineral material and the fiber material to form a fiber suspension* [column 6 lines 8-17]). The refiner acts to activate the fibers to enhance fiber bonding (*activating the fiber suspension in the*

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*activation zone in order to enhance the capacity of the fibers for bonding [column 7 lines 16-20]). Carbon dioxide gas is fed into the refiner (feeding the gas comprising the precipitant inside the precipitation reactor [column 7 lines 35-40]). The refiner serves to mix the fibers, calcium hydroxide and carbon dioxide and refine the fibers while precipitating out carbon dioxide. The fibers with precipitated calcium carbonate are then discharged from the refiner (bringing the dispersed and activated fiber suspension into contact with the precipitant of the reactive mineral material in the precipitation reactor in order to at least partly precipitate the reactive mineral material discharging the treated fiber suspension from the precipitation reactor [column 7 lines 35-40 and 47-60]).*

KLUNGNESS et al. discloses that the calcium carbonate loaded pulp is made into paper. KLUNGNESS does not disclose the common steps of making the paper including sending the paper solution to the forming section of a paper machine, removing water from the paper through a permeable base, and then drying the paper web to form paper (*feeding the paper pulp containing precipitated mineral material at a predetermined consistency into a forming section of a paper machine; removing water from the paper pulp by allowing the pulp to drain through a water permeable forming base; and drying and finishing the paper web thus produced in order to produce a finished paper product [column 1 lines 25-35]).*

KLUNGNESS et al. does not state that the paper is 'finished'; however finishing is well known and commonly practiced technique in the paper making industry. SMOOK discloses finishing such as calendaring. At the time of the invention it would have been *prima facie* obvious to a person of ordinary skill in the art to 'finish' the paper of

KLUNGNESS. A person of ordinary skill in the art would be motivated to calendar the paper since most papers are calendared [SMOOK pg. 272].

KLUNGNESS et al. does not disclose dispersing the fiber suspension in drops or particles into the precipitation reactor. VIRTANEN discloses a calcium carbonate precipitation process wherein the calcium hydroxide is dispersed in a mist (drops), and then precipitates out in carbon dioxide [abstract]. At the time of the invention it would have been obvious to perform the fiber loading process of KLUNGNESS et al. by dispersing the fiber/calcium hydroxide as a mist through carbon dioxide as taught by VIRTANEN and using the pin mill of VIRTANEN as the activating refiner (*dispersing the fiber suspension in drops or particles into the precipitation reactor*). A person of ordinary skill in the art would be motivated to combine the fiber loading process of KLUNGNESS et al. with the pin mill apparatus of VIRTANEN because VIRTANEN teaches that the pin mill apparatus has a low retention time [abstract], and because gas phase dispersion is used only 1/1000 of the energy is required as the liquid phase dispersion [column 3 lines 39-50]. VIRTANEN also states that disc (the refiner of KLUNGNESS) or cone refiners [column 4 lines 20-25] can also meet the purpose of the disclosed invention. Further, it would be *prima facie* obvious to substitute known one type of grinding device such as a disk refiner for another known grinding device such as a pin mill for the same purpose for known and predictable results.

As for claim 23, KLUNGNESS et al. discloses calcium hydroxide [column 7 lines 42-48].

As for claim 24, KLUNGNESS et al. discloses the precipitant carbon dioxide [column 7 lines 16 and 17].

As for claim 25, KLUNGNESS et al. discloses refining which activates the fibers by grinding and fibrillating them in a disk refiner [column 7 lines 15-40]. Alternatively, the pin mill of VIRTANEN would also serve to grind the pulp and therefore activate it [Figure 3 and column 5 lines 20-23].

As for claim 29, VIRTANEN discloses that the residence time of a pin mill where the activation would take place is less than 1 second [abstract].

As for claim 30 and 31, VIRTANEN discloses that the carbon dioxide should have a degree of purity of 90% or more, which the examiner has interpreted as nearly pure carbon dioxide. KLUNGNESS et al. discloses that the carbon dioxide should be supplied to the refining/precipitation unit as a pressurized gas [column 7 lines 23-24].

As for claim 32, VIRTANEN discloses that the precipitation reactors (the pin mill refiners) can be connected in series [figure 1a and 1b]

As for claim 33, both KLUNGNESS and VIRTANEN disclose calcium hydroxide. KLUNGNESS et al. further discloses that the calcium hydroxide is added to change the desired opacity of the paper [column 2 lines 7-11].

As for claim 34, KLUNGNESS et al. discloses chemical and mechanical pulps [column 1 lines 58-60].



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As for claim 35, KLUNGNESS et al. discloses chemical pulps. All chemical pulps contain residual mineral impurities such as sodium carbonate and other substances not removed during screening such as excess dirt or shives. A mechanical pulp contains fiber based fines.

As for claim 36, KLUNGNESS discloses that the pulp is fed at 5 to 15% consistency which overlaps with the instant claimed range [column 7 lines 5-10].

9. Claims 26-28 and 37-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over KLUNGNESS et al., in view of U.S. Patent 6,416,727 VIRTANEN, hereinafter VIRTANEN and Handbook for Pulp and Paper Technologists by SMOOK, hereinafter SMOOK, as applied to claims 22-25, 29, 30, 31, 32, 33, 34, 35, and 36 above, and further in view of WO 96/18454, hereinafter '454.

As for claim 26 and 27, VIRTANEN discloses a pin mill mixer which will supply impact and counter impacts as it is the same device as the instant claim [Figure 3]. VIRTANEN et al. further discloses an impact mill type flow through mixer, a pin mill mixer. VIRTANEN discloses that every other cage can act as a rotor [Figure 4] or all the cages can act as a rotor [Figure 3]. VIRTANEN discloses grinding pins which the examiner has interpreted as blades [column 5 lines 10-22]. The suspension flows through the pin mill mixer/refiner as shown in Figures 3 and 4. VIRTANEN et al. does not disclose the speed of the pin mill. '454 publication discloses that the pin mill should be run at a speed of 20-200 m/s. At the time of the invention it would have been obvious to a person of ordinary skill in the art to run the pin mill at the speed disclosed by '454 publication. It is *prima facie* obvious to apply a known technique such as operation

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speed to a known device such as a pin mill. A person of ordinary skill in the art could readily expect the pin mill to refine pulp and cause impact forces on the pulp moving through it at these speeds. Alternatively, it would have been prima facie obvious to optimize the speed of the concentric rotors as speed has a direct effect on the refining of the fibers and hence the uptake of precipitated calcium carbonate [KLUNGNESS column 7 lines 13-15 and see e.g. MPEP 2144.05 (II) (B) Optimization of ranges and result effective variables]. The rotating of the cages of VIRTANEN impacts/mills the fibers and subjects them to shearing/turbulence.

As for claim 28, VIRTANEN discloses that carbon dioxide can be fed into the turbulent zone (activation zone) at different intermediate stages of the carbonating process [column 4 lines 65-67 column 5 line 1-4].

As for claim 37, KLUNGNESS discloses a method for manufacturing paper loaded with calcium carbonate [abstract]. KLUNGNESS discloses a precipitation reactor, the refiner (*providing a precipitation reactor* [column 7 lines 5-12]). KLUNGNESS discloses that the fibers, which have a capacity for bonding, are sent to the refiner after being mixed with calcium hydroxide, a reactive mineral is mixed with the fiber (*providing a fiber material comprising fibers to be used as a raw material for the paper pulp, the fibers in the fiber material having a certain capacity for bonding and providing a reactive mineral material* [column 1 lines 25-29, column 6 lines 8-17, column 7 lines 7-12]). KLUNGNESS then discloses carbon dioxide a gas capable of precipitating out the reactive mineral (*providing a gas containing a precipitant capable of precipitating the reactive mineral material* [column 7 lines 16-20]). The calcium hydroxide and fibers are combined to form a suspension (*combining the reactive mineral material and the fiber*

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*material to form a fiber suspension [column 6 lines 8-17]). The refiner acts to activate the fibers to enhance fiber bonding (activating the fiber suspension in the activation zone in order to enhance the capacity of the fibers for bonding [column 7 lines 16-20]). Carbon dioxide gas is fed into the refiner (feeding the gas comprising the precipitant inside the precipitation reactor [column 7 lines 35-40]). The refiner serves to mix the fibers, calcium hydroxide and carbon dioxide and refine the fibers while precipitating out in the carbon dioxide. The fibers with precipitated calcium carbonate are then discharged from the refiner (bringing the dispersed and activated fiber suspension into contact with the precipitant of the reactive mineral material in the precipitation reactor in order to at least partly precipitate the reactive mineral material discharging the treated fiber suspension from the precipitation reactor [column 7 lines 35-40 and 47-60]). KLUNGNESS et al. discloses that the calcium carbonate loaded pulp is made into paper. KLUNGNESS does not disclose the common steps of making the paper including sending the paper solution to the forming section of a paper machine, removing water from the paper through a permeable base, and then drying the paper web to form paper (feeding the paper pulp containing precipitated mineral material at a predetermined consistency into a forming section of a paper machine; removing water from the paper pulp by allowing the pulp to drain through a water permeable forming base; and drying and finishing the paper web thus produced in order to produce a finished paper product [column 1 lines 25-35]).*

KLUNGNESS et al. does not state that the paper is 'finished'; however finishing is well known and commonly practiced technique in the paper making industry. SMOOK discloses finishing such as calendering. At the time of the invention it would have been *prima facie* obvious to a person of ordinary skill in the art to 'finish' the paper of

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KLUNGNESS. A person of ordinary skill in the art would be motivated to calender the paper since most papers are calendered [SMOOK pg. 272].

KLUNGNESS et al. does not disclose dispersing the fiber suspension in drops or particles into the precipitation reactor. VIRTANEN discloses a calcium carbonate precipitation process wherein the calcium hydroxide is dispersed in a mist (drops), and then precipitates out carbon dioxide [abstract].

VIRTANEN et al. further discloses an impact mill type flow through mixer, a pin mill mixer. VIRTANEN discloses that every other cage can act as a rotor [Figure 4] or all the cages can act as a rotor [Figure 3. The suspension flows through the center of the pin mill and then radially through outer cage exit from the pin mill mixer/refiner as shown in Figures 3 and 4. *(every other cage functions as a rotor, and the cages adjacent to the mentioned cages function as stators or rotors, feeding apparatus for feeding the fiber material mainly into the center of the cages; and an open outer cage that allows the fiber suspension to flow radially outwards through the cages to exit the cage in different directions, or an outer cage that is provided with one or more outlets in order to discharge the fiber suspension flowing radially outwards from the cages* [column 5 lines 10-22 ,Figures 2-4])

At the time of the invention it would have been obvious to perform the fiber loading process of KLUNGNESS et al. by dispersing the fiber/calcium hydroxide as a mist through carbon dioxide as taught by VIRATEN and using the pin mill of VIRATEN as the activating refiner *(dispersing the fiber suspension in drops or particles into the precipitation reactor).*

A person of ordinary skill in the art would be motivated to combine the fiber loading process of KLUNGNESS et al. with the pin mill apparatus of VIRTANEN because VIRTANEN teaches that the pin mill apparatus has a low retention time [abstract], and because gas phase dispersion is used only 1/1000 of the energy is required as the liquid phase dispersion [column 3 lines 39-50]. VIRTANEN also states that disc (the refiner of KLUNGNESS) or cone refiners [column 4 lines 20-25] can also meet the purpose of the disclosed invention. Further, it would be *prima facie* obvious to substitute known one type of grinding device such as a disk refiner for another known grinding device such as a pin mill for the same purpose for known and predictable results.

VIRTANEN et al. does not disclose the speed of the pin mill. '454 publication discloses that the pin mill should be run at a speed of 20-200 m/s which overlaps with the instant claimed range. At the time of the invention it would have been obvious to a person of ordinary skill in the art to run the pin mill at the speed disclosed by '454 publication. It is *prima facie* obvious to apply a known technique such as operation speed to a known device such as a pin mill. A person of ordinary skill in the art could readily expect the pin mill to refine pulp and cause impact forces on the pulp moving through it at these speeds. Alternatively, it would have been *prima facie* obvious to optimize the speed of the concentric rotors as speed has a direct effect on the refining of the fibers and hence the uptake of precipitated calcium carbonate [KLUNGNESS column 7 lines 13-15 and see e.g. MPEP 2144.05 (II) (B) Optimization of ranges and result effective variables].

As for claim 38, the fibers of KLUNGNESS et al. are exposed to calcium hydroxide before being sent to a refiner/activator [column 6 lines 13-17]. It is the

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position of the examiner that these fibers would swell the same as the instant claimed invention as the properties of a substance can not be separated from the composition of the substance and the calcium hydroxide treated fibers of KLUNGNESS et al. are *prima facie* the same as those of the instant application.

As for claim 39 and 40, KLUNGNESS et al. discloses the overlapping range of adding 10 to 40% calcium hydroxide which precipitates into calcium carbonate [column 6 lines 44-45]. VIRTANEN discloses that the precipitated calcium carbonate is nano-sizes [column 2 lines 50-55].

As for claim 41-43, calendering, sizing, and coating are all common, well known process for paper making in the industry. SMOOK discloses all three processes [pg. 272, 283, 286]. At the time of the invention it would have been *prima facie* obvious to a person of ordinary skill in the art to size, calender, or coat the paper of KLUNGNESS/VIRTANEN as it is obvious to apply known techniques to a known product such as paper ready for improvement.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent 6,202,946 describes the use of a pin mill for defibrating fibers [abstract].

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANTHONY J. CALANDRA whose telephone number is

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(571) 270-5124. The examiner can normally be reached on Monday through Friday, 7:30 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AJC

/Eric Hug/  
Primary Examiner